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09/513,239	02/24/2000	Paul W. Romig	28542.00059	6208

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EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT PAPER NUMBER

3728

DATE MAILED: 05/21/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/513,239

Applicant(s)

ROMIG ET AL.

Examiner

Shian T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-10 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-10, 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 7/25/02 has not been approved. The original disclosure does not disclose the specific shape and structure of the needle nor the structure and shape of the food contained within the package. Although applicant modified the drawings to overcome the objection from the previous Office Action, but the shape of the needles and the structure of the food will introduce new matter into the specification.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the IV bag and plastic-wrapped food package must be shown or the features canceled from claims 24-25. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 8-10 and 22-25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Katsura et al (US 5,223,315) in view of Heider (US 5,405,667) and Admitted Prior Art.

Katsura et al suggest a container equipped with a label. The label in Figure 1-B has a print layer 3 attached to a metallic layer 5. The metallic layer is bonded to the container. Figure 1C shows a print layer 3 attached to a metal layer 5a and the metal layer 5a is attached to a lower polymeric layer 2a. Katsura et al disclose generally all of the elements of the claims, but lacks a metallized polyester layer bonded directly to the bottle without adhesive. Heider teaches a plastic container having a multilayer label heat bonded thereto. In the background section of the specification, Heider stated that it has been found that applying the labels during the molding process reduce costs of manufacture and produces an attractive container. Conventionally, adhesive is on the label and is heated to adhere the label to the container. However, the use of such a label has inherent problem in that when the plastic container cools, the plastic and paper have different rate of shrinkage and the paper wrinkles and stresses occur in the adhesive. To prevent such occurrence, Heider provided a label used in the labeling process that adhere to the bottle without adhesive. Also, Admitted Prior Art on page 1 of the specification discloses the conventional placement of a label on a semi-permeable plastic container. This includes bottles, cellophane-wrapped styrofoam plates and IV fluids bag. Thus, it would have been obvious in view of Heider and Admitted Prior Art to adhere the label with the metallized layer directly to the container without adhesive to prevent wrinkles. It would have also have been obvious to one having ordinary skill in the art at the time the invention was made to make the metal layer out of metallized polyester, since it has been held to be within the general skill of a worker in the art to

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select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Applicant argues that the specification of the applied art does not teach or disclose the newly amended language. This includes “by heating the metallic layer to a temperature where an adjacent portion of the external surface is melted so that the metallic layer is thereby fused to the external surface upon cooling below the temperature” and “the temperature at which the metallic layer is heated is between about 80 degrees Fahrenheit...” and “the temperature at which the metallic layer is heated is about 105 degrees Fahrenheit.” However, the claim language modified the product claim into a product by process claim. It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims. Hence, as long as the metallic layer is bonded to the external surface of the semi-permeable container, it is immaterial in a product claim when the claim language is directed to the method of heating the metallic layer to a certain temperature for bonding.

### ***Conclusion***

4. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information

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without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148** or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302 and for After Final Amendment the number is (703) 872-9303. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on T-F from 7:00am to 4:00pm EST.

STL  
May 20, 2003

  
Primary Examiner  
Shian Luong  
Art Unit 3728